

## **REMARKS**

The Applicants thank the Office for withdrawing some of the previous rejections and respectfully request reconsideration of the present application in view of the foregoing amendments and the reasons that follow.

### **I. Status of the Claims**

Claim 1 is amended to clarify the recitation of R<sup>1</sup> and R<sup>2</sup>, wherein R<sup>1</sup> indicates a hydrogen atom or a linear or branched fatty acid residue and R<sup>2</sup> indicates a linear or branched fatty acid residue having 1 to 24 carbon atoms or a benzoic acid residue. Support for the amendment can be found in, for example, lines 24-26 on page 3 of the Specification as filed. New claim 6 is added to further recite that R<sup>2</sup> is a behenic acid (i.e., docosanoic acid, or CH<sub>3</sub>(CH<sub>2</sub>)<sub>20</sub>COOH), which is a linear or branched fatty acid residue having 1 to 24 carbon atoms, as recited in claim 1, and the supported of which can be found in, for example, lines 24-26 on page 3 of the Specification. Support for using behenic acid as an ingredient can also be found in, for example, lines 30-37 on page 4 of the Specification. No new matter is introduced, and claims 1-6 are currently pending to be examined on their merits.

### **II. Claim Rejection – 35 U.S.C. § 112**

Claims 1-5 are rejected under 35 U.S.C. § 112, ¶1, as allegedly failing to comply with the written description requirement. Without acquiescing to the grounds of the rejection, claim 1 is amended to recite that “R<sup>1</sup> indicates a hydrogen atom or a linear or branched fatty acid residue and R<sup>2</sup> indicates a linear or branched fatty acid residue having 1 to 24 carbon atoms or a benzoic acid residue.” As provided in the previous section, the amendments are fully supported by the Specification. Thus, at least in view of the foregoing, the Applicants respectfully request that the rejection be withdrawn.

### III. Claim Rejection – 35 U.S.C. § 103

Claims 1-3 are rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Mitsumatsu (WO 02/19977 A1), and claims 4-5 are rejected under 35 U.S.C. § 103(a) over Mitsumatsu, in view of Healy (WO 00/26285). The Applicants respectfully traverse.

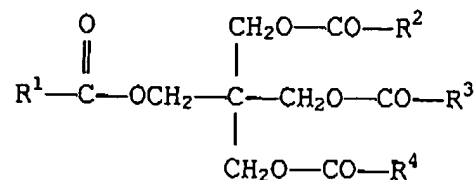
#### (i) Present Claims Are Not Obvious over Mitsumatsu

The Office asserts that because the R groups of Mitsumatsu are encompassed by the present claims, the compounds of Mitsumatsu would lead one of ordinary skill in the art to reach the presently claimed compositions. Page 3, Office Action. The Applicants respectfully traverse.

While not acquiescing to the grounds of rejection, claim 1 is amended with respect to the recitation of R<sup>1</sup> and R<sup>2</sup>. Nowhere does Mitsumatsu teach or suggest such recitation as provided in claim 1.

The Applicants also maintain the position, as stated in the August 20, 2008 reply, that not only are the presently claimed compositions non-obvious over Mitsumatsu, but they also provide unexpected beneficial results over Mitsumatsu. The mere fact that Mitsumatsu discloses pentaerythritol ester oil does not lead one of ordinary skill in the art to the presently claimed compositions, as merely having pentaerythritol ester derived oil ingredients is insufficient to achieve the unexpected desirable properties provided by the presently claimed compositions. In fact, as provided in the August 20, 2008 reply, particularly in Table 1 provided therein, the desired results can be obtained only when the pentaerythritol ester having two or three benzoic acid residues, as recited in independent claim 1, are used (see Examples 1 and 2 and Experiments A and 8 in Table 1). Mitsumatsu never discloses or suggests such teaching.

In particular, Mitsumatsu discloses a hair care composition comprising a pentaerythritol ester oil having the formula:



which is similar to those of the compounds used in Examples 1 and 2 and Comparative Example 1 as provided in the present Specification. However, as shown in Example 1 and Comparative Example 1 in Tables I and II of the present Specification, the use of tribenzoic acid ester (see Examples 1 and 2) and the use of dibenzoic acid ester (see Experiments A and B in Table 1 in the August 20 2008 reply) can provide the desired results, while the use of tetra-2-ethylhexanoic acid ester can **not**.

Thus, contrary to the Office's assertion, the resulting compounds depend on more than just the pentaerythritol ester oil. In the absence of the pentaerythritol ester having **two or more benzoic acid residues**, which is not taught or suggested by Mitsumatsu, but is recited in formula (1) of independent claim 1 and new claim 6, even if, *arguendo*, the pentaerythritol ester oil were used, one of ordinary skill in the art would not necessarily reach the presently claimed compositions with their unexpected desirable properties (i.e., applicability, stickiness, gloss on lips, moisture feeling, and cosmetic durability).

Thus, the Applicants respectfully submit that not only are claims 1-3 non-obvious over Mitsumatsu, but claim 6 is also separately patentable.

(ii) No Reason to Combine Mitsumatsu and Healy

The Applicants further maintain the position that one of ordinary skill in the art would not have had a reason to combine the teachings of Mitsumatsu and Healy and respectfully reiterate

the determination of obviousness as delineated by the U.S. Supreme Court in *KSR Int'l Co.*, as discussed in the August 20, 2008 reply. Neither Mitsumatsu nor Healy teaches or suggests a composition as presently claimed, particularly with respect to the structure comprising **two or more benzoic acid residues**. Additionally, the teachings of Mitsumatsu and Healy, alone or in combination, cannot provide the unexpectedly desirable results provided by the presently claimed compositions, as shown above - the Office acknowledges that the prima facie obviousness can be rebutted with a showing of unexpected results, citing also MPEP § 2144.09. Page 5, Office Action. The lack of obviousness can also be evidenced in the commercial success with respect to the total sales of the presently claimed compositions for over US \$13 million dollars, as discussed in the August 20, 2008 reply. Thus, one of ordinary skill in the art would not have had a reason to combine the teachings of Mitsumatsu and Healy, and even if they were combined, the presently claimed compositions would not result.

Therefore, at least in view of the foregoing, the Applicants respectfully request that the rejection be withdrawn.

### **CONCLUSION**

The Applicants believe that the present application is now in condition for allowance and respectfully request favorable reconsideration of the application.

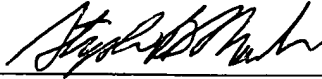
The Office is invited to contact the undersigned by telephone if a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing or a credit card payment form being unsigned, providing incorrect information resulting in a rejected credit card transaction, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of

time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. § 1.136 and authorize payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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By 

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